

serious burden on the Examiner to prosecute the inventions of Groups I and II in the present application.

The Examiner rejects claims 1-6 and 12 as being obvious over Ho, however the Examiner has not established a prima facie case of obviousness.

The Examiner erroneously takes the position that it would have been prima facie obvious at the time of the invention to leave the components of Ho in the unreacted form as a matter of design to "increase the shelf life of the coating." (Office Action p. 4) Such an assumption is an incorrect interpretation of resins and coating compositions in general and Ho in particular.

The Examiner, cites to the clearcoat in Ho (col. 24 lines 26-28), and specifically Example 8 (columns 29-30 and 38) wherein Ho discloses the preparation of a polyurethane dispersion by reacting a polyol, a polyisocyanate, and 2-butyl-2-ethyl-1,3-propanediol (BEPD). The Examiner erroneously opines that it would be obvious to leave those components in the unreacted form to increase the shelf life of the coating.

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More particularly, a coating composition as in Ho, comprising a polyol, a polyisocyanate and 2-butyl-2-ethyl-1,3-propanediol (BEPD) is not storage stable due to the fact that the functional groups of the reactants are able to react with each other at room temperature. When one looks at the Examples provided in the present invention, the pot life of such a coating composition is quite short, i.e. 50 minutes (example 1), 115 minutes (example 2) and 85 minutes (example 3). Accordingly, these coating compositions are reacted in a couple of hours.

On the other hand, a resin prepared from these three reactants does not have any functional groups left able to react with each other. For example, hydroxy functional groups may be present, but no isocyanate groups are present in the resin itself to react with the hydroxyl groups. Therefore, such a resin is storage stable for a couple of months, if not years.

Thus, if the Examiner's hypothesis was correct (which it is not), one would not choose for a coating composition the three reactants as in the present invention, but rather would simply have the coating composition comprising the resin itself. Especially, if the properties of the coatings

thereof would be the same. This is certainly not the case, and, therefore, it cannot be said that a coating composition having three reactants is obvious from a coating composition having a polyurethane dispersion prepared as in No. from these three reactants.

More particularly No discloses coating compositions, i.e. a two part reactive polyurethane composition either water or solvent borne (column 1, lines 7 and 8). This coating composition further comprises two parts A and B in which the resins of part A may be chosen from the group of:

- a) a urethane prepolymer,
- b) a first acrylic polyol,
- c) a second acrylic polyol,
- d) a first compound, and
- e) a second compound consisting of diols and polyols.

Meanwhile, Part B may be a polyisocyanate compound.

In contrast, the present invention claims a coating composition comprising:

- Ah) a hydroxy group-containing film forming polymer with a hydroxy value between 75 and 300 mg KOH/g solid resin,

- Ae) a diol of the general formula  $\text{HO}-\text{CH}_2-\text{CR}(\text{C}_2\text{H}_5)-\text{CH}_2-\text{OH}$ ,  
wherein R is an alkyl group having 3-6 carbon atoms,  
and  
B) a polyisocyanate compound.

In column 17 and 18, Ho describes the second compound Ae) which may be a diol. The only compound exemplified is a melamine polyol. It is not disclosed nor suggested in Ho the second compound in the coating composition may be a diol according to the general formula of claim 1 of the present invention.

Although in Ho, BEPD is mentioned as a reactant for the urethane prepolymer Aa) it is not disclosed nor suggested by Ho that this reactant can also be applied in the coating composition itself.

Finally, diols of the general formula disclosed in claim 1 of the present invention must be used to obtain the excellent results of the present invention, not every diol can be used. As can be seen in Example 2 and Comparative examples A to F (Spec. pp. 15-18) of the present invention, several coating compositions are prepared with diols as the

As compound. As can be seen from the results in Table 3, it is only with a coating composition according to the present invention comprising a diol according to the general formula in claim 1, i.e. BEPD, that good properties are obtained. Ho does not disclose or suggest that the use of a diol of the general formula as set forth in claim 1 of the present invention in coating composition comprising a polyol and a polyisocyanate which would provide these excellent results.

The Examiner also erroneously states that claim 3 of the present invention is obvious in light of Ho. For at least the reasons set forth above, a prima facie showing of obviousness has not been established under the prior art of Ho. The mere fact that the cited references may be modified does not establish a prima facie case of obviousness based on such modification absent a suggestion in the cited art of the desirability of the modification. In re Fritch, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992)

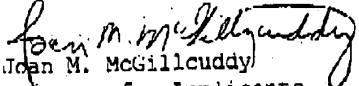
Obviousness cannot be established merely by locating a reference which describe various aspects of an invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the

present invention. Applicants submit that it is clear that the applied reference, taken as a whole, fails to provide such motivating force, and that such force is only provided by the present invention's disclosure.

In view of the distinguishing remarks made above applicants respectfully request reconsideration and withdrawal of the subject rejection.

In view of the amendments and remarks herein, the papers submitted previously, the present application is believed to be in condition for allowance, which action is respectfully requested.

Respectfully submitted,

  
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